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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM P. ALBERTH, JR., MICHAEL D. KOTZIN and ROB BERO

Appeal 2010-002046
Application 09/610,768
Technology Center 2600

Before JAMESON LEE, HOWARD B. BLANKENSHIP, and KARL D. EASTHOM, *Administrative Patent Judges*.

PER CURIAM.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 4, 12, and 17. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Representative Claim

4. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device;

b) monitoring the microphone for audio signals; and

c) sending the stored message from the wireless device after a call is established if audio signals have not been detected being picked-up by the microphone of the wireless device; and

d) never sending the stored message from the wireless device in connection with the call initiated from the wireless device, if audio signals have been detected being pick-up by the microphone of the wireless device.

DISCUSSION

In the sole rejection still maintained against the claims, the Examiner rejects claims 4, 12, and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 2, 5-10, 13-16, 18-24, and 26-30 are allowed. Claims 3, 11, and 25 have been canceled.

The instant written description (Spec. 8:9 - 9:6, 10:29 - 11:2) and the drawings (Figs. 2, 3) disclose that upon initiation of an emergency 911 call a prerecorded message is sent from the cell phone if the user's voice is not detected within a predetermined time. Claim 4, which we determine to be representative in the appeal, recites limitations about detecting "audio signals" rather than voice.

The Examiner's statement of the rejection in the Answer seems to suggest that the claims are thought to confuse the user's voice with the pre-stored audio message (prerecorded message) that may be transmitted. *See,*

e.g., Spec. 5:34 - 6:11. However, the Response to Argument section of the Answer makes the basis for the rejection clear.

> In this instant case, the appellant is trying to obtain a patent which covers a whole set of audio signals including user's voice, tones, music, noises, dog barking, bird chirping, sirens, etc, wherein as disclosed in the specification, the termination of sending the stored message is based on . . . the detection of **the user's voice signals** . . . and not any and all types of audio signal. . . . This is simply a matter of the applicant originally disclosing a narrow scope and then later attempting to gain patent coverage for a broader and larger scope. Hence the 112 rejection.

Ans. 5.

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). The inquiry is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). In view of the Examiner's Response, the scope of the claims are reasonably ascertained as covering all detectable types of audio signals, which include the voice signals specified in the written description. As the claims have not been shown to be indefinite, we do not sustain the § 112, second paragraph rejection of the claims.

The rejection appears to be based on an alleged lack of written description support and/or enablement (35 U.S.C. § 112, first paragraph). However, as Appellants point out in the Reply Brief, sending the stored message if there is no detection of "audio signals" is consistent with claims 4, 12, and 16 as originally filed. As the rejection has also failed to show that the disclosure, including the original claims, does not provide an adequate

written description for the presently claimed detecting of "audio signals," and has not demonstrated that the disclosure fails to provide enablement for the claimed invention, a satisfactory basis for a rejection under the first paragraph of § 112 has not been set forth.

DECISION

The Examiner's decision to reject claims 4, 12, and 17 is reversed.

REVERSED